

In accordance with the requirements of 37 C.F.R. § 1.121, the attached Appendix shows the changes that have been made by the proposed amendments.

## **REMARKS**

### **I. Status of the Claims**

Claims 17, 18, 20, 21, and 23-36 are pending in this application. Claim 19 has been cancelled without prejudice or disclaimer. Claims 17 and 35 have been amended to recite that the washing base is present in an amount ranging from 4% to 50% by weight with respect to the total weight of the composition. Support for this amendment can be found, for example, in original claim 19, now cancelled. Accordingly, no new matter has been added. Further, these amendments do not raise any new issues or necessitate the undertaking of any additional search of the art by the Examiner. All of the elements and their claimed relationships were earlier recited in the claims as examined. See e.g., original claim 19.

Therefore, the Amendment under 37 C.F.R. § 1.116 should allow for immediate action by the Office. The proposed amendments, moreover, place the claims in better condition for allowance, or at least in better form for appeal, if necessary.

### **II. Rejection Under 35 U.S.C. § 102(b)**

Claims 17, 18, 23-30, 32 and 34-36 stand rejected 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 4,529,586 ("*De Marco*") for the reasons set forth at pages 2 and 5-6 of the outstanding final Office Action. Applicants respectfully traverse this rejection.

A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in, and must be arranged as required by, the claim. See M.P.E.P. § 2131.

The presently claimed invention, as now recited in the amended claims, is directed to, *inter alia*, "[a] detergent and conditioning composition comprising, in a cosmetically acceptable medium, a washing base and a conditioning system, wherein the washing base is present in an amount ranging from 4% to 50% by weight with respect to the total weight of the composition." See, e.g., claim 17. *De Marco*, on the other hand, does not disclose a detergent composition, a washing base, or a composition comprising a washing base in an amount ranging from 4% to 50% by weight with respect to the total weight of the composition, but rather, teaches a hair conditioning composition containing an amino functional silicone polymer in aqueous emulsion, a cationic surfactant emulsifier, and a cationic polymer. See, e.g., Abstract and column 1, lines 19-24.

In the final Office Action, the Examiner first asserts that "the term 'detergent' is in the preamble which carries no patentable distinction." See page 5 of the final Office Action. However, the preamble of a claim limits the claim if it "breathes life and meaning into the claim." M.P.E.P. § 2111.02. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." *Id.*; see also Kropa v. Robie, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (C.C.P.A. 1981). In Kropa, a preamble reciting 'An abrasive article' was deemed essential to point out the invention defined by the claims to an article comprising abrasive grains and a hardened binder

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and the process of making it. The C.C.P.A. said that "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" *Id.* (emphasis added). Thus, *Kropa* stands for the proposition that, where the preamble serves to further define the article produced by the claimed components, the preamble should be given patentable weight.

In the present case, as in *Kropa*, the preamble "a detergent and conditioning composition" is essential to point out that the invention defined by the claims is directed to a composition that simultaneously cleans and conditions the hair. See e.g., page 1, line 3 of the specification. However, the Examiner contends that "[a]bsent any specific property or chemical structure..., even water...reads on the instant washing base." See page 5 of the present Office Action. Although Applicants disagree with this statement as applied to the present invention for reasons discussed below, the Examiner's statement itself shows that "it is only by [the] phrase ["detergent" in the preamble] that it can be known that the subject matter defined by the claims is comprised as ["a detergent and conditioning composition"]. *Kropa*, 187 F.2d at 152. Accordingly, the preamble of the present claims serves to further define the inventive composition and cannot be ignored.

Further, as the Federal Circuit has recently emphasized, the "claims are always construed in light of the specification, of which they are a part." *Networld, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001). In the present case, the specification repeatedly recites that detergent compositions are generally used for the cleaning and/or washing of hair. See e.g., page 1, lines 12 - page 2, line 2, page 5, line

1, and page 6, lines 1-5 of the specification. Accordingly, in contrast to the Examiner's assertion, when the claims are construed in light of the specification of which they are a part, the term "washing base" would not encompass *De Marco's* compositions, nor would it encompass water alone. See e.g., page 6, lines 1-5 of the specification.

Moreover, even the plain meaning of the term "washing" in the phrase "washing base" distinguishes it from *De Marco's* compositions and from water alone. For example, The American Heritage College Dictionary, (Third Edition), at page 1522 (a copy of which is enclosed herewith), defines the adjective "washing" as "[u]sed for washing." In turn, "to wash" is defined as "[t]o cleanse, using water or other liquid, usu[ally] with soap, detergent, or bleach, by immersing, dipping, rubbing, or scrubbing." *Id.* Thus, the "specific property" of the washing base that distinguishes it from water is inherent in the term "washing." In contrast, *De Marco* does not contain a washing base and is not directed to washing at all. Rather, *De Marco* discloses "a conditioning composition" and clearly indicates that washing is not one of the properties of the compositions disclosed therein. See e.g., column 1, lines 48-50 (reciting that "shampooing . . . can take place before or after treatment with the conditioner of the present invention") and column 2, lines 12-43 and column 6, lines 16-25 (reciting that the cationic surfactants act to emulsify the silicone polymer in aqueous emulsion, reduce static retention, and are believed to prime the hair surface and promote the deposition of the conditioning silicone from the emulsion).

Finally, Applicants maintain that there is no teaching in *De Marco* that the cationic surfactant emulsifiers of *De Marco* would function as washing bases given the stated purpose of *De Marco's* surfactants and the teaching that the cationic surfactants

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are present at relatively low concentrations in their compositions, such as from about 0.11% to 0.4%, or 0.1% to 1.5% (see, e.g., column 2, lines 35-43 and column 6, lines 32-34). In contrast, the present claims require that the inventive compositions comprise a washing base in an amount ranging from 4% to 50% by weight with respect to the total weight of the composition. Thus, the recited concentrations of surfactants in *De Marco's* compositions are not sufficient for "washing" as claimed, i.e., to "confer a satisfactory foaming and/or detergent power on the final composition" as recited at page 6 of the present specification.

For the above reasons, each and every limitation of the present claims is not taught or suggested by *De Marco*. Accordingly, as Applicants' presently claimed invention is not anticipated by this reference, Applicants respectfully request that the rejection be withdrawn.

### **III. Rejections Under 35 U.S.C. § 103(a)**

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. See M.P.E.P. § 2143. Furthermore, there must be a reasonable expectation of success in such a modification or combination. *Id.* Finally, the prior art references must teach or suggest all the claimed limitations. *Id.*

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A. De Marco Alone

Claims 17-21, 23-30 and 32-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *De Marco*, for the reasons set forth at pages 3 and 6 of the final Office Action. Applicants respectfully traverse this rejection.

For the reasons discussed above, *De Marco* fails to teach or suggest all the limitations of the presently claimed invention. Moreover, there is no teaching or suggestion in *De Marco* that would have motivated the skilled artisan to modify the reference to include a washing base, let alone in an amount ranging from 4% to 50% by weight with respect to the total weight of the composition, nor has the Office pointed to any such motivation, as it must to satisfy its burden.

In the final Office Action, the Examiner asserts that "optimizing the amount of cationic surfactant in the composition would have been obvious for one of an ordinary skill in the art so as to achieve optimum conditioning effect." See page 6 of the final Office Action. As a preliminary matter, Applicants note that the Examiner's statement concerning the examples at pages 31-33 of the present application is erroneous. Specifically, the exemplified compositions comprise 0.2 grams of cationic polymer - not surfactant.

Further, Applicants submit that, even if, *arguendo*, one of ordinary skill in the art would have been motivated to optimize the amount of cationic surfactant in *De Marco*'s compositions so as to achieve an optimum conditioning effect, the "optimized" amount would not fall within the scope of the present claims. First, as previously discussed, the surfactants in *De Marco*'s compositions are in a conditioning composition, not a detergent and conditioning composition. Second, *De Marco* expressly warns that,

although a "concentration of the cationic surfactant from about 0.11% to about 0.4% by weight resulted in an improvement in reducing static retention,...**increasing the concentration of the cationic surfactant above a point begins to decrease the overall conditioning efficiency of the composition.**" See col. 2, lines 36-43. *De Marco* repeats this warning throughout. See e.g., col. 6, lines 8-10 (reciting that "**the functioning of the composition...is sensitive to the effective concentration limits of the cationic surfactant**"); see also col. 6, lines 17-21 (reciting that **above the effective concentration limit, [the cationic surfactant] tends to re-emulsify the deposited silicone**").

Thus, as *De Marco* teaches, increasing the concentration of the cationic surfactant in his composition beyond a certain point may not result in "optimized" conditioning effect at all. Accordingly, one of ordinary skill in the art would not have been motivated to increase the amount of the cationic surfactant in *De Marco* to a point where it would fall within the scope of the present claims nor would there have been a reasonable expectation of success in doing so.

For at least these reasons, the Examiner has failed to establish a prima facie case of obviousness, and thus the rejection should be withdrawn.

**B. *De Marco* in view of *Reich***

Claims 17-21 and 23-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *De Marco* in view of WO 94/06403 ("*Reich*"), for the reasons set forth at pages 4 and 7 of the Office Action. Applicants respectfully traverse this rejection.

In the Office Action dated November 27, 2001, the Examiner asserted that "it would have been obvious for a skilled artisan at the time of the instant invention to use the copolymer [of *Reich*]...in the hair conditioning compositions of [*De Marco*]." See page 4. In the present Office Action, however, the Examiner states that the "motivation to use the conditioning composition of *De Marco* with a cleansing shampoo comes from the teachings of *Reich* that conditioning the hair while cleaning is useful and enables more manageability to the hair."

Applicants do not see how adding the copolymer of *Reich*, which is expressly required to have a "hair conditioning effect," to the conditioning compositions of *De Marco* could impart the cleansing effect that the Examiner claims serves as motivation to make the modification in the first place.

Further, there would not have been the requisite motivation to combine the entirety of both the composition of *Reich* and that of *De Marco*, particularly when each composition is described as beneficial and successful on its own. For example, *Reich* claims that the compositions disclosed therein already "provide enhanced hair conditioning benefits significantly greater than that provided by other commonly employed 'two-in-one' compositions." See page 3, lines 17-19. *De Marco* provides no motivation to combine the entirety of both compositions either.

Finally, in the final Office Action, the Examiner states for the first time that

"optimizing the amounts of surfactants between 5 to 40% by weight would have been obvious for a skilled artisan because *Reich* suggests that **anionic** surfactants are conventionally used in the above range as **detergents**. Thus, optimizing the amounts of surfactants to achieve the optimum cleansing effect would have been within the scope of a skilled artisan."



See page 7 of the final Office Action (emphasis added). However, *De Marco's* compositions do not contain anionic surfactants and are not detergents.

Further, *De Marco* does not teach or suggest the desirability of a cleansing effect nor of incorporating anionic surfactants into the compositions disclosed therein.

In contrast, *De Marco* teaches that a "further benefit of the cationic polymer derives from the discovery that upon shampooing of the hair with an anionic surfactant the cationic polymer forms *in situ* on the hair a conditioning complex which will further improve the durability of the conditioning effect to last through several shampoos." See col. 1, lines 42-47. Specifically, the ***cationic polymer "forms a bond with the negatively charged sites of the hair"*** and then the "remaining free ***positive charges of the cationic polymer react in the presence of hair with the anionic surfactant residue from a preceding shampoo or with such a surfactant from a subsequent shampoo to form a durable conditioning complex on the hair which remains attached to the hair and conditions it.***" See col. 5, line 56 - col. 6, line 2.

Thus, even if, *arguendo*, the proposed modification were made, *i.e.*, anionic surfactants in an amount ranging from 5 to 40% by weight were added to *De Marco's* compositions comprising a cationic polymer in an amount ranging from 0.05% to about 0.5% by weight, one of ordinary skill in the art would not have had a reasonable expectation of success. Specifically, based on the teachings of *De Marco*, if 5 to 40% by weight of anionic surfactants were combined with *De Marco's* cationic polymer, one of ordinary skill in the art

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would expect the cationic polymer to react with the anionic surfactant to form a complex prior to their application to hair, as opposed to forming a complex that includes the hair as in *De Marco*. Such complexation prior to application to hair could result in decreased reactivity with the hair itself, thereby resulting in less conditioning of the hair.

Further, the proposed modification would, according to *De Marco*, change the principle of operation of the compositions disclosed therein. It is well known that the teachings of references are not sufficient to render the claims prima facie obvious where the proposed modification would change the principle of operation of the prior art invention being modified. See e.g., M.P.E.P. § 2143.01.

For at least these reasons, the Examiner has failed to establish a prima facie case of obviousness, and thus the rejection should be withdrawn.

#### **IV. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request entry of the proposed amendments and reconsideration and reexamination of this application.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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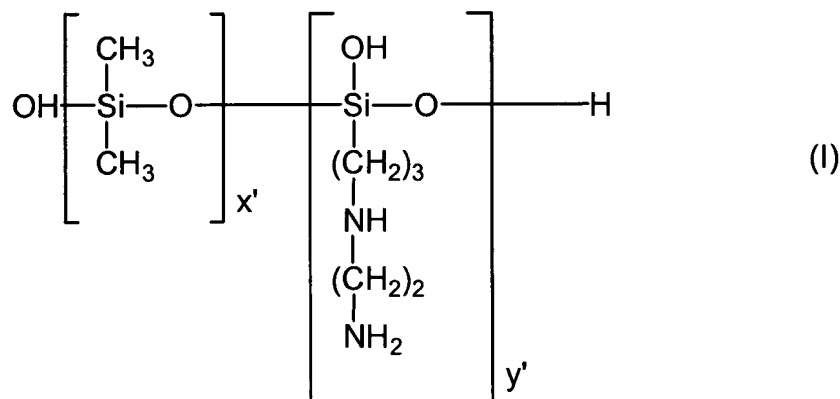
## APPENDIX

Version of amended claims with markings to show changes made, pursuant to 37 C.F.R. 1.121(c)(1)(ii).

Claims 17 and 35 were amended, as follows:

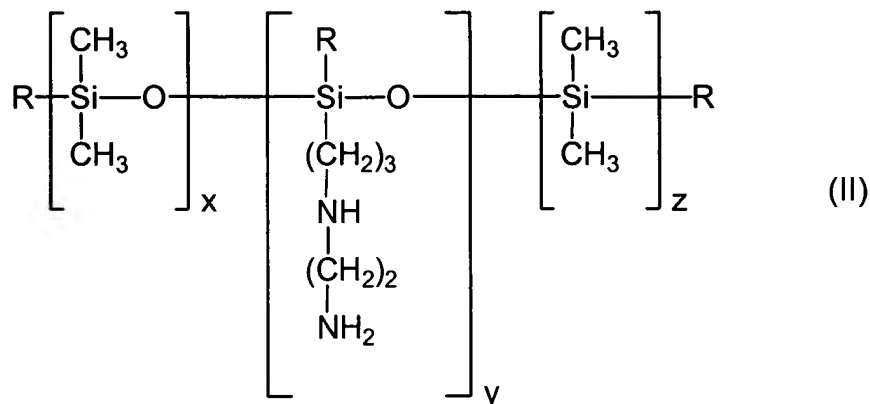
17. (Amended) A detergent and conditioning composition comprising, in a cosmetically acceptable medium, a washing base and a conditioning system, wherein the washing base is present in an amount ranging from 4% to 50% by weight with respect to the total weight of the composition, and further wherein the conditioning system comprises at least one cationic polymer and at least one amine-comprising silicone with a weight-average molecular mass ranging from 11,000 to 25,000, wherein the amine-comprising silicone is chosen from:

(a) polysiloxanes corresponding to the formula (I):



in which  $x'$  and  $y'$  are integers that depend on the weight-average molecular mass, wherein the molecular mass ranges from 11,000 to 25,000, and

(b) polysiloxanes corresponding to the formula (II):



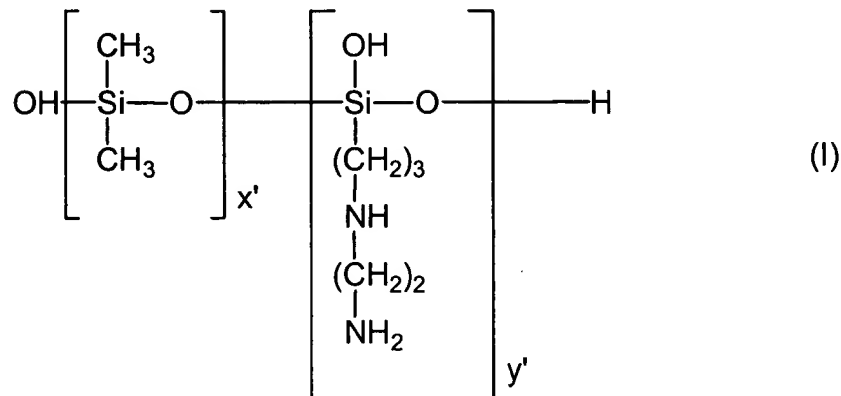
in which R denotes OH, x, y, and z are integers that depend on the weight-average molecular mass, and wherein the weight-average molecular mass ranges from 11,000 to 25,000.

35. (Amended) A process for washing and conditioning keratinous substances comprising:

a) wetting the keratinous substances;

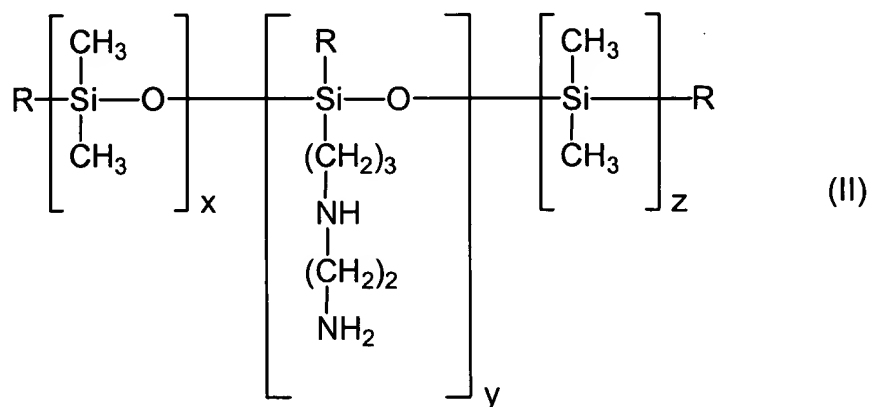
b) applying to the wetted keratinous substances an effective amount of a composition comprising, in a cosmetically acceptable medium, a washing base and a conditioning system, wherein the washing base is present in an amount ranging from 4% to 50% by weight with respect to the total weight of the composition, and further wherein the conditioning system comprises at least one cationic polymer and at least one amine-comprising silicone with a weight-average molecular mass ranging from 11,000 to 25,000, wherein the amine-comprising silicone is chosen from:

(i) polysiloxanes corresponding to the formula (I):



in which  $x'$  and  $y'$  are integers that depend on the weight-average molecular mass, wherein the molecular mass ranges from 11,000 to 25,000, and

(ii) polysiloxanes corresponding to the formula (II):



in which R denotes OH,  $x$ ,  $y$ , and  $z$  are integers that depend on the weight-average molecular mass, and wherein the weight-average molecular mass ranges from 11,000 to 25,000; and

c) rinsing the keratinous substances with water.